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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,412	10/15/2003	Kenichi Kusunoki	15468-005001	8605

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FISH & RICHARDSON, PC
12390 EL CAMINO REAL
SAN DIEGO, CA 92130-2081

EXAMINER

JONES, DAVID B

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,412

Applicant(s)

KUSUNOKI ET AL.

Examiner

David B Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10, and 14-21 is/are rejected.
- 7) ☒ Claim(s) 11-13 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

2. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-8 are method claims and as such should be set forth as active methods steps to arrive at the desired operation. As presently set forth, claims 1-8 are drafted in a narrative fashion. Further the limitation "can be", as found in at least claims 3, 5, and 9, renders the claims indefinite, failing to clearly set forth the applicant's invention; all the claims should be reviewed for such verbiage. In claim 6, "its peripheral edge", "the top end section", "the outer periphery of the upper die", and "the peripheral edge section", and "the central section", all lack antecedent basis. Further in claim 6, line 3, "clamped" is misspelled. Claims 9-14 are drawn to apparatus claims, these claims should be reviewed so as to positively recite each element and correlate each with respect to each other. Claims 15-21, as with the other claims, appear to be a translation from a foreign document and as such should be reviewed and amended to set forth claim language commensurate with U.S. patent practice.

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5-10, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 19717953 (See Figs 1-3). Regarding claims 5 and 14, the workpiece of the reference DE '953 "can be" surface treated.

4. Claims 11-13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001-259,752 in view of Clark et al. JP '752 teaches the claimed invention excepting the fluid characteristics. It is well known in the art of hydroforming to use glycol as a forming fluid (see Clark, column 3, lines 22). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the forming fluid in JP '752 as a glycol to provide the known advantages thereof, such a provision being an obvious choice of known forming fluids well known in the art. To have provided the fluid in a

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certain viscosity and with certain compression characteristics would have been manifested under routine experimentation, rendering no new or unobvious results.

6. Claims 15-21 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2001-259,752. Claims 15-21 are product-by-process claims. Even though product-by-process claims are limited by and defined by the process; determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. The patent office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature then when a product is claimed in the conventional fashion. In re Fessmann, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). In this case the prior art reference to JP '752 teaches the claimed product of a fuel cell composed of a great number of convex sections. In that this is the only limitation on the product and in that the prior art teaches the claimed limitation, patentability is precluded under 35 USC 102(b).

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

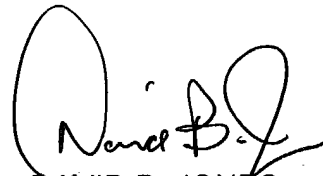
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David B. JONES whose telephone number is (703) 308-1887.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148.

In the event that the Applicant(s) wishes to communicate via Fax, the current central Fax number for the patent office is (703) 872-0906

DBJ

A handwritten signature in black ink, appearing to read "David B. Jones", written over a circular stamp.

DAVID B. JONES
PRIMARY PATENT EXAMINER
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